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09/859,416	05/18/2001	John William Lumley	1509-176	4833

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EXAMINER

QIN, YIXING

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/859,416

Applicant(s)

LUMLEY, JOHN WILLIAM

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-30 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-18, 20-25, 27 is/are rejected.
- 7) ☒ Claim(s) 5, 19 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

In response to applicant's amendment received 2/28/05, all requested changes have been entered. New claims 24-30 have been added.

### ***Response to Arguments***

The Examiner does agree that this Manico reference does not disclose a digital film medium and the use of a feed path to scan a selection sheet. However, new references has been found to teach the use of a digital film medium and that the printed order form can be fed back to a printer with scanning capabilities to identify the selected images. Also, prior art has been found to suggest the termination of a print process if identifiers do not match.

The Attorney notes that it would not have been obvious to have a plurality of selection fields from Manico's reference. The Examiner will now further cite Hicks to show an ordering system where the order sheet has a plurality of selection fields. The Examiner is allowing the claims dealing with the deletion fields because no prior art have been found to explicitly disclose this feature. Please see the reasons below.

### ***Allowable Subject Matter***

Claims 5, 19, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2622

Claim 28-30 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The above mentioned claims refer to a selection sheet with a deletion field for indicating the deletion of an image in a digital field medium when marked and scanned.

The Examiner would like to note that the deletion of images is well known as being performed electronically (i.e. on a computer, digital camera, etc.) However, the claimed invention calls for a deletion field on a selection sheet to be marked and is not explicitly disclosed by the prior art.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1-4 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota (U.S. Patent No. 6,169,596) and in view of Hicks (U.S. Patent No. 5,359,387).

#### **1. Claim 1 (currently amended):**

**A method of selecting prints of photographs from a digital film medium, the method comprising:**

- Shiota discloses in column 1, lines 11-16, that systems have been suggested to take images from the memory of a digital camera. Please also note Ueda et al (Japanese Application No. 11-268201, which corresponds to U.S. Patent No. 6,806,974 – Fig. 4)

Art Unit: 2622

- **(i) printing a selection sheet of thumbnail representations photographs available on the medium to be printed, the selection sheet further comprising a plurality of selection fields each thumbnail representation being associated with at least one selection field**
- Shiota discloses in column 3, lines 43-47 and item 8 of Fig. 1. This order sheet has a blank space for filling in order info, which is similar to the purpose of selection fields. The secondary reference, Hicks, discloses in Fig. 2 selection fields associated with each image for the ordering of a particular package.
- **(ii) marking one or more of said selection fields according to a user choice of photographs to be printed**
- Shiota discloses in column 3, lines 18-23 that an user can fill in pertinent information, such as the number of prints, regarding images to be printed. Also note the above figure in Hicks that shows a circled selection field.
- **(iii) inspecting the selection sheet to determine which of said selection fields has been marked in step (ii); and**
- Shiota discloses in column 3, lines 31-35 that the information from an order sheet may be gathered by a scanner and OCR.
- **(iv) performing one or more actions relating to the photographs stored on said digital medium, in accordance with said marked selection fields.**
- Shiota discloses in column 3, lines 36-41 that the images may be printed.
- Both references are in the art of providing an user with an index print of thumbnail images for the ordering of images to be printed. This will serve as the motivation for the combination of these references from hereon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a selection sheet like the one from Fig. 2 of Hicks when using the invention of Shiota. The motivation would be for simplicity of selection of pre-identified packages.

## 2. Claim 2 (original)

**A method according to claim 1, wherein for each thumbnail representation a corresponding plurality of selection fields are provided.**

- The secondary reference, Hicks, discloses in Fig. 2 that multiple packages are available for each image.

## 3. Claim 3 (currently amended):

**A method according to claim 2, wherein**

- **step (iv) includes a printing step and one type of said corresponding plurality of selection fields designates a print format in which the photograph represented by said thumbnail representation is to be printed in step (iv).**
- The secondary reference, Hicks, discloses in Fig. 2 that multiple packages (i.e. print format) are available for each image to be printed.

Art Unit: 2622

**Claim 4 (currently amended):**

**A method according to claim 2, wherein**

- **step (iv) includes a printing step and one type of said corresponding plurality of selection fields designates a number of prints of photographs corresponding to a particular thumbnail representation to be printed in step (iv).**
- Shiota discloses in column 3, lines 15-18 that the order sheet has blanks for size and quantity. Note in column 3, lines 45-48 that the index prints 8 could substitute as an order sheet. Also see Fig. 2 of Hicks, where the various packages have different quantities of prints and sizes.

**Claim 8 (previously presented):**

**A method according to claim 1, wherein**

- **step (iv) is a printing step and in step (ii) a user fills in one or more of the selection fields according to user choice of photograph to be printed, user choice of number of prints of said photographs to be printed and user choice of format of said photograph to be printed.**
- Shiota discloses in column 3, lines 15-18 that the order sheet has blanks for size and quantity. Note in column 3, lines 45-48 that the index prints 8 could substitute as an order sheet. Also see Fig. 2 of Hicks, where the various packages have different quantities of prints and sizes and that an user can circle (or just as likely fill in) a package number for prints to be printed.
- Hicks also discloses in column 3, lines 62-64 that if an user does not wish to print a certain image, then simply not select a package.

**Claim 9 (previously presented):**

**A method according to claim 1, wherein**

- **marking of said selection fields in step (ii) comprises filling in said selection field so as to change said selection field from a light, unselected, condition to a dark, selected, condition.**
- Hicks discloses the circling of a field. Although it would be obvious to simply fill in the box as the filling in of fields is common knowledge.

**Claim 10 (previously presented):**

**A method according to claim 1, wherein**

- **in said step (iii) the marked selection sheet is scanned.**
- Shiota discloses in column 3, lines 31-35 that the information from an order sheet may be gathered by a scanner and OCR.

**Claim 11 (previously presented):**

**A method according to claim 1, wherein**

- **in said step (iii) only those parts of the selection sheet corresponding to selection fields are inspected and the information gleaned from the**

Art Unit: 2622

**inspection is processed to determine whether said selection fields are marked or unmarked.**

- Shiota discloses in column 3, lines 31-35 that the information from an order sheet may be gathered by a scanner and OCR. The Hicks reference also discloses in column 4, lines 16-26 that an operator or a machine may discern marks made on an order form.

II. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota (U.S. Patent No. 6,169,596) in view of Hicks (U.S. Patent No. 5,359,387) and further in view of Ishii (U.S. Patent No. 5,940,168).

**Claim 6 (previously presented):**

**A method according to claim 1, wherein**

- **said selection sheet is also provided with an identifier which is unique to the digital film medium and, wherein in step (iii) said unique identifier is inspected in a preliminary step and, if the unique identifier does not correspond to a unique identifier allocated to the digital film medium, then the method terminates.**
- Neither Shiota nor Hicks discloses the checking of an identifier. However, the tertiary reference, Ishii, discloses in Fig. 1 and column 7, lines 15-22 the use of a bar-code on both an index print 15 and on a bag containing negatives 19 for identification purposes. Although this is not a digital medium, it would be obvious to one of ordinary skill to apply this concept to a digital film medium. One would also understand that printing of images would not occur if there is a code mismatch. Please also note Fig. 11 of Manico et al from the last office action.
- All three references are in the art of printing thumbnails of photos and the use of the thumbnails to facilitate the ordering of prints. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a bar code for identification purposes. The motivation would be to prevent the printing of the wrong images or images not belonging to a particular customer

**Claim 7 (original):**

**A method according to claim 6, wherein**

- **said unique identifier comprises a bar code.**
- Please see claim 6 above.

III. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota (U.S. Patent No. 6,169,596) in view of Hicks (U.S. Patent No. 5,359,387) and further in view of Miyamoto et al (U.S. Patent No. 6,456,391 – "Miyamoto").

**Claim 12 (currently amended):**

Art Unit: 2622

**A method according to claim 1, the method being performed by a printer including a scanning mechanism in a feed path of the printer, wherein in step**

- **the selection sheet is printed on the basis of data input directly to the printer by a digital film media interface, activating the printer to print out said selection sheet which is thereafter, in**
- Neither the Shiota nor the Hicks reference discloses that the digital film medium can be directly inserted into a printer and that the printer has scanning capabilities to scan the selected images. However, the tertiary reference, Miyamoto, discloses in Fig. 2 a printer that has a card slot 30 can receive data from a PC card (i.e. digital images from a camera – note column 1, lines 12-26).
- **step (ii), manually marked by a user according to the user choice, the mark selection sheet then being input to the printer feed path and scanned by the scanning mechanism so as to perform the inspecting**
- Miyamoto discloses in column 5, lines 3-8 that a user can select at least one thumbnail on an index print. Column 5, lines 22-33 discloses the feeding of the index print with the selection(s) back into the printer for the detection of selected images.
- **step (iii), data obtained during the inspecting step then being used to perform the printing in step (iv) of said one or more photographs.**
- Miyamoto discloses in column 5, lines 44-47 the printing of a selected image.
- All three references are in the art of producing images based on the selection of images to be printed. Therefore, it would be obvious to have a printer that has direct input and the scanning capabilities to recognize selected images on an index print. The motivation would be to make it easier for users, since they can simply perform the entire process using one machine.

IV. Claims 13-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al (U.S. Patent No. 6,456,391 – “Miyamoto”).

**Claims 13 and 23 (currently amended): A digital film enabled printer, said printer including**

- **a print head,**
- Miyamoto discloses in Fig 2, a thermal head 37.
- **a first interface for reading data from a digital film medium,**
- Miyamoto discloses in Fig 2, a card slot 30.
- **a user interface for receiving commands from a user,**
- Miyamoto discloses in Fig 2, a switch substrate 28 with a led panel.
- **a detector located in a paper sheet feed path of the printer,**
- Miyamoto discloses in Fig 1 and column 3, lines 10-19, photo-reflectors that can detect marks on a paper being transported.
- **a processor for processing data from said digital film medium and user commands from said user interface,**



Art Unit: 2622

- Miyamoto discloses in Fig 2, a CPU 18.
- **the processor being arranged to create and to print out, using the print head, a selection sheet of thumbnail representations for photographs available on the medium to be printed,**
- Column 4, lines 49-54 discloses the CPU controlling the thermal head to print. Lines 60-64 disclose the printing of the index print 56.
- **said selection sheet further comprising a plurality of selection fields, each of said thumbnail representations being associated with at least one of said selection fields,**
- The Miyamoto reference does not explicitly disclose multiple selection fields, but rather in Fig. 5 that a check can be placed. The secondary reference, Hicks, discloses in Fig. 2 a plurality of selection fields associated with each image.
- **the processor being further arranged for processing data from said detector so as to enable a user marked selection sheet input to the printer via the printer feed path to be inspected and a determination to be made as to which, if any, selection fields have been marked by the user and to enable the performance of one or more actions relating to the photographs stored on the digital film medium in accordance with the marked selection fields.**
- Miyamoto discloses in column 5, lines 22-47 the printing of selected image(s) after the scanning of the index print to see which images are to be printed. Again, if there was a field, it would be obvious for one to mark a field.

**Claim 14 (previously presented):****A printer according to claim 13, wherein**

- **said detector comprises a scanning mechanism associated with the print head of the printing means.**
- Miyamoto discloses in column 3, lines 17-19 that the CPU received a signal from each photo-reflector. The CPU, as mentioned above in claim 1, is used to control the thermal head. Thus, the photo-reflectors indirectly tell the thermal head which images to print.

**Claim 15 (previously presented):****A printer according to claim 14, wherein**

- **said scanning mechanism is attached to the print head and movable transversely across the feed path in response to signals from the processor.**
- This is not explicitly disclosed by Miyamoto, but he does suggest in column 3, lines 51-54 that a movable detecting means may be used instead of the photo-reflectors. It would be an obvious design choice to attach the detector to a print head, since a print head would normally traverse the paper.

Art Unit: 2622

V. Claims 16-18, 20, 24, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al (U.S. Patent No. 6,456,391 – “Miyamoto”) in view of Hicks (U.S. Patent No. 5,359,387).

**Claim 16 (original):**

**A printer according to claim 13, wherein**

- **for each thumbnail representation printed a plurality selection fields are printed.**
- Please see Hicks, Fig. 2

**Claim 17 (previously presented):**

**A printer according claim 13, wherein**

- **one type of said plurality of selection fields designates, when marked, the print format in which the photograph represented by said thumbnail representation is to be printed.**
- Again in Hicks, Fig. 2, one can see different packages to be ordered in different print formats.

**Claim 18 (previously presented):**

**A printer according claim 16, wherein**

- **one type of said selection fields designates, when marked, the number of prints of photographs corresponding to a particular thumbnail representation to be printed.**
- Again in Hicks, Fig. 2, one can see the different packages have different numbers of associated prints to be made. Also note in Shiota that the user can fill in a blank with the number of prints.

**Claim 20 (previously presented):**

**A printer according to claim 13, wherein**

- **said processor is further arranged to read a unique identifier from the digital film medium via the first interface and to create and print out, using the print head, a unique sheet identifier on said selection sheet.**
- Miyamoto does not disclose an unique identifier. Hicks shows in Fig. 2 a group name or code and frame number. Also note that Manico et al shows in Fig. 11 frame numbers and barcodes.

**Claim 24 (new): A method of printing images carried by a digital film medium by using an apparatus including a reader of the images on the digital film medium, (b) printer for forming thumbnail photographs of the images read by the reader and a selection field associated with each of the photographs, and (c) a detector for markings on the selection fields; the method comprising:**

- As mentioned above in claim 13/23, the Miyamoto reference does not explicitly disclose a selection field, although a check mark can be made. The Hicks reference discloses in Fig. 2 a plurality of selection fields associated with

Art Unit: 2622

- **inserting the digital causing the reader to film medium into the reader;**
- **read the images on the digital film;**
- Miyamoto discloses in column 4, lines 30-35 the inserting and reading of the digital film medium.
- **applying a sheet to the printer;**
- Miyamoto discloses in Fig 1 and column 2, lines 60-64 a printing paper 10.
- **transferring the images read by the reader to the printer thence to the sheet applied to the printer so thumbnail photographs of the transferred images are printed by the printer on the sheet;**
- Miyamoto discloses in column 3, lines 20-23 an index print.
- **causing the printer to apply to the sheet a selection field for each of the thumbnail photographs on the sheet;**
- The Miyamoto reference does not explicitly disclose multiple selection fields, but rather in Fig. 5 that a check can be placed. The secondary reference, Hicks, discloses in Fig. 2 a plurality of selection fields associated with each image.
- **marking the selection field associated with at least one of the thumbnail photographs;**
- Miyamoto discloses in column 5, lines 22-47 the printing of selected image(s) after the scanning of the index print to see which images are to be printed. Again, if there was a field, it would be obvious for one to mark a field.
- **reinserting the sheet with the thumbnail photographs and the marked selection field into the apparatus;**
- **reading the marked selection field with the detector; and**
- **subsequently printing the at least one thumbnail photographs in accordance with the markings therefor.**
- Miyamoto discloses the last three limitations in column 5, lines 24-47.

**Claim 25 (new):**

**A method according to claim 24, wherein**

- **the images are transferred to the sheet by causing the sheet to move relative to the printer via a predetermined path; and**
- Miyamoto discloses in column 4, lines 49-54 that the CPU controls the thermal head to apply color to the paper 10. Although Miyamoto does not go into great detail about the formation of the image on the printer, common printing techniques involve the moving of a piece of paper along a path with rollers and having images applied thereto.
- **causing the sheet when reinserted into the apparatus, to move relative to the detector via the same predetermined path.**
- One can see in Fig. 1 of Miyamoto that the sheet is moving relative to a detector.

**Claim 27 (new):**

**Apparatus comprising the reader, printer and detector set forth in the preamble of claim 24 in combination with**

Art Unit: 2622

- **a processor for performing the transferring, reading and both causing steps of claim 24.**
- Miyamoto discloses in column 4, lines 30-35 that the CPU reads from the digital film medium and supplies the info to the DRAM controller. Although not all steps are explicitly disclosed as being done by the CPU, the CPU is the control logic that drives the functions of the printer.

VI. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al (U.S. Patent No. 6,456,391 – “Miyamoto”) in view of Hicks (U.S. Patent No. 5,359,387) and further in view of Ishii (U.S. Patent No. 5,940,168).

**Claim 21 (previously presented):**

**A printer according to claim 20 wherein**

- **said detector is further arranged for reading the unique sheet identifier and, the processor is arranged so that if the unique sheet identifier does not correspond the unique identifier of the digital film media, then the performance of said one or more actions is inhibited.**
- Neither Miyamoto nor Hicks discloses the checking of an identifier. However, the tertiary reference, Ishii, discloses in Fig. 1 and column 7, lines 15-22 the use of a bar-code on both an index print 15 and on a bag containing negatives 19 for identification purposes. Although this is not a digital medium, it would be obvious to one of ordinary skill to apply this concept to a digital film medium. One would also understand that printing of images would not occur if there is a code mismatch.
- All three references are in the art of printing thumbnails of photos and the use of the thumbnails to facilitate the printing selected images. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a bar code for identification purposes. The motivation would be to prevent the printing of the wrong images or images not belonging to a particular customer

**Claim 22 (previously presented):**

**A printer according to claim 20, wherein**

- **said unique sheet identifier comprises bar code.**
- Please see claim 21 above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381.


The examiner can normally be reached on M-F 9:30-6:00.

Art Unit: 2622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER